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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,354	12/31/2003	David C. Wolfe	20031027-001	9467
34160	7590	06/23/2005	EXAMINER	
SUD-CHEMIE INC. 1600 WEST HILL STREET LOUISVILLE, KY 40210			BROWN, JENNINE M	
		ART UNIT	PAPER NUMBER	
		1755		

DATE MAILED: 06/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/750,354	WOLFE ET AL.	
	Examiner	Art Unit	
	Jennine M. Brown	1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-21 is/are pending in the application.
 - 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-21 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: ____. |

Claims Analysis

According to MPEP 2113, “[e]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985) (citations omitted). The examiner is interpreting claims 1-21 as product by process claims and as such the patentability depends upon the product itself and not necessarily the process by which the product is produced, unless applicant comes forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Claim Rejections - 35 USC § 102/ Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-4, 6-8, 10-14, 16-21 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hoffman, et al. (US 6224793 B1).

See entire document. Hoffman, et al. disclose an active catalyst (col. 3, l. 61-col. 6, l. 6) having a protective coating material ("encapsulating agent") comprising a crystallizable or thermoplastic polymer (col. 2, l. 60-col. 3, l. 58; col. 6, l. 48-61). The catalyst would inherently be spherical, hemispherical, ellipsoidal, oval, domed or flaked. The transition point of the polymer is between 40-250 degrees C in the molten liquid state (col. 9, l. 48-60; col. 10, l. 20-25). The particles have a particle size of about 10 micron to about 3000 microns (col.

11, I. 30-36). The hydrocarbon material is polyethylene, polyethylene glycol (col. 6, I. 56-57). The concentration of the catalyst is preferably 70 weight percent or less of the encapsulating agent (col. 47-57). Particle sizes are given for air milled and spray dried compared to rotating disk (col. 16, I. 4-col. 17, I. 56).

Since the prior art appears to disclose the invention as claimed on the basis of inherent property characteristics which either anticipate or render the claimed product obvious, an alternative 35 U.S.C. 102/103 rejection is deemed appropriate and the burden of proof that it does or does not shifts to the applicant as in *In re Best* 195 USPQ 430, 433 (CCPA 1877).

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Daage, et al. (US 6624204 B1).

See entire document. Daage, et al. disclose a wax coated oxidized catalyst (col. 9, I. 60-col. 10, I. 20) wherein the wax comprises between 1 to 50% of the mixture (col. 6, I. 48-53) and the particle size is from 1-500 microns (col. 8, I. 11-13). The catalyst would inherently be spherical, hemispherical, ellipsoidal, oval, domed or flaked. The density of the catalyst would inherently be greater than that of the hydrocarbon material or the catalyst because the catalyst would coat the wax if the opposite were true.

Since the prior art appears to disclose the invention as claimed on the basis of inherent property characteristics which either anticipate or render the claimed product obvious, an alternative 35 U.S.C. 102/103 rejection is deemed

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appropriate and the burden of proof that it does or does not shifts to the applicant as in *In re Best* 195 USPQ 430, 433 (CCPA 1877).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennine M. Brown whose telephone number is (571) 272-1364. The examiner can normally be reached on M-R 9:30 AM - 7:30 PM; Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

jmb


J. A. LORENZO
SUPERVISORY PATENT EXAMINER